

DOCKET NO. SC11588TK

PTO/SB/17

**MOTOROLA****FAX TRANSMITTAL SHEET**

Motorola, Inc.  
Law Department  
7700 W. Parmer Lane  
MD: TX32/PL02  
Austin, TX 78729

Telephone: (512) 996-6839  
Facsimile: (512) 996-6854

FAX COPY RECEIVED

**AUG 27 2002**

TECHNOLOGY CENTER 2800

**4** Number of Pages (including this page)

Date: August 27, 2002  
To: Examiner Chris Chu - Group 2815  
Location: United States Patent and Trademark Office  
Fax No.: (703) 308-7382  
From: Susan C. Hill (Registration No. 35,896)  
Subject: Serial No. 10/008,800 - Mark A. Gerber

I hereby certify that this correspondence is being facsimile transmitted to the Patent and Trademark Office on:

8/27/02 Elaine Cox Elaine Cox  
Date Printed Name Signature

**MESSAGE:**

Enclosed herewith, please find a **RESPONSE TO A RESTRICTION/ELECTION REQUIREMENT** for filing in the above-identified application.

**ALL ITEMS MARKED WITH AN "X" ARE INCLUDED IN THE FAX**

1.	X	1 page Fax cover sheet
2.	X	3 page Response to a Restriction/Election Requirement

**PLEASE GIVE THESE PAPERS TO:**

EXAMINER: Chris Chu  
GROUP ART UNIT 2815  
SERIAL NO.: 10/008,800  
FILED: November 8, 2001  
INVENTOR: Mark A. Gerber

## UNITED STATES PATENT AND TRADEMARK OFFICE

APPLICANT(S) Mark A. Gerber /  
APPLN. NO.: 10/008,800  
FILED: November 8, 2001  
TITLE: SEMICONDUCTOR PACKAGE DEVICE AND METHOD OF FORMATION AND TESTING

GROUP ART UNIT: 2815  
EXAMINER: Chris Chu

*#4*  
*Election*  
*J. M. Miller*  
*7/3/02*

Certificate of Transmission under 37 CFR  
1.8

I hereby certify that this correspondence is being  
facsimile transmitted to the Patent and  
Trademark Office.

on 8/27/02

Elaine Cox  
Signature

Elaine Cox  
Printed Name of Person Signing Certificate

RESPONSE TO A RESTRICTION/ELECTION REQUIREMENT

Commissioner for Patents  
Washington, D.C. 20231

Sir:

Responsive to the Office Action dated August 1, 2002, and Examiner's comments  
with regard thereto, please enter the following Response to the Restriction/Election  
Requirement in the above-entitled application, without prejudice or disclaimer.

FAX COPY RECEIVED

AUG 27 2002

TECHNOLOGY CENTER 2800

**REMARKS**

Withdrawal of the restriction requirement is respectfully requested. Applicants traverse the restriction requirement because the restriction requirement does not meet the requirements of 35 U.S.C. §121 and search and examination of the entire application would not be a serious burden on the Examiner.

The Examiner has identified two sets of claims, as listed below:

Group I: Claims 1-15, directed towards a method of forming a package device

Group II: Claims 16-27, directed towards a package device

Species I: depicted in FIGS. 1-12

Species II: depicted in FIGS. 13-23

Applicants respectfully submit that the claims of Groups I and II are not independent and distinct from each other. The Examiner has argued that the product (Group II) can be made by a materially different process, such as testing the ICs without applying test probes to the pads. Applicants respectfully point out that claim 3 is the only independent claim that involves testing by applying test probes. Independent claims 1 and 6 (independent method claims) cover both testing by applying test probes and testing without applying test probes. Thus independent claims 1 and 6 are not limited to the process of testing the ICs by applying test probes to the pads. Therefore, the example that the Examiner provided (testing each IC on a test board) is covered by independent claims 1 and 6. Therefore, the Examiner has failed to show how the product as claimed in Group II can be made by a materially different process than that claimed in Group I.

Based on the Examiner's argument regarding testing the ICs without applying test probes to the pads, the following grouping of claims would be more proper:

Group A: Claims 1-2 and 6-27, covers both testing by applying test probes and testing without applying test probes

Group B: Claims 3-5, requires testing by applying test probes

In regard to the species distinction drawn by the Examiner, it appears to Applicants that all of the claims of Group II read on both the embodiment of FIGS. 1-12 and the embodiment of FIGS. 13-23. Consequently, Applicants do not believe it is necessary to chose a species.

The Examiner has also failed to show how the process as claimed can be used to make a materially different product. Therefore, the claims of Group I and II are not distinct as asserted by the Examiner. Hence, the Applicants request that the Examiner organize the claims of Groups I and II into one group.

In addition, the search and examination of all claims would not be a serious burden on the Examiner. A search of the method claims would involve searching for a package device having two ICs or having pads on two sides, which are included in the structure claims. The Examiner will inherently search the subject matter included within the structure claims when he or she searches the method claims. Accordingly, examination of the claims of Group I and Group II is not a serious search burden on the Examiner. Therefore, the Examiner must examine the entire application on the merits even if it includes claims to independent and distinct inventions (which Applicants submit is not true in regards to Groups I and II).  
M.P.E.P. § 803.


If the restriction requirement is not withdrawn, Applicants elect to prosecute the invention of claims 1-15 (Group I). However, if the Examiner regroups the claims as suggested by the Applicants, Applicants elect claims 1-2 and 6-27 (Group A). Please contact the Applicants' practitioner below if there are any issues regarding this communication or the current Application.

Respectfully submitted,

SEND CORRESPONDENCE TO:

Motorola, Inc.  
Law Department

Customer Number: 23125

By:   
Susan C. Hill  
Attorney of Record  
Reg. No.: 35,896  
Telephone: (512) 996-6839  
Fax No.: (512) 996-6854

3

FAX COPY RECEIVED

AUG 27 2002

TECHNOLOGY CENTER 28001